

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 99-372-F)**

**PATENT**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RENEWED PETITION UNDER 37 CFR 1.137(b)**

In response to the Decision on Petition mailed July 13, 2009, Applicants respectfully request reconsideration of the decision dismissing Applicants' Petition to Revive an Unintentionally-Abandoned Application submitted with respect to U.S. Application No. 09/927,850 ("the '850 application"), which was unintentionally abandoned on March 7, 2005 for failure to file a request for extension of time on Monday, August 8, 2005.

Applicants respectfully submit that the '850 application did not become abandoned on March 7, 2005 as the result of a deliberately chosen course of action, and therefore, that the abandonment of the '850 application on March 7, 2005 was unintentional (M.P.E.P. § 711.03(c)(II)(C)(1)). In addition, Applicants submit that evidence in the record clearly supports their contention that the abandonment of the '850 application on March 7, 2005 was unintentional, and that at no time from March 7, 2005 until the submission of this Renewed Petition under 37 CFR 1.137(b) did Applicants intend for the '850 application to become abandoned on March 7, 2005.

In prosecuting the '850 application and related U.S. Application Nos. 09/724,860 ("the '860 application") and 11/200,389 ("the '389 application") on behalf of Applicants, Applicants' undersigned representative was assisted by, and supervised the work of, Dr. Donald L. Zuhn, Jr. Therefore, in support of the instant Renewed Petition, Applicants hereby submit the Declaration of Donald L. Zuhn, Jr. ("Declaration").

On January 6, 2005, Dr. Zuhn filed a Notice of Appeal (Exhibit A), appealing the final rejection of claims 1-20 in the '850 application (Declaration, ¶ 2). At the time the Notice of Appeal was filed, Dr. Zuhn also filed a Petition for a Three-Month Extension of Time and a Transmittal Letter containing a general authorization to charge or credit fees (Exhibit A; Declaration, ¶ 2).

On August 8, 2005, Dr. Zuhn withdrew the above Notice of Appeal by filing a continuation application – U.S. Application No. 11/200,389 (the '389 application) – claiming the benefit of the '850 application (Declaration, ¶ 3). At the time the '389 application was filed, Dr. Zuhn included a Utility Patent Application Transmittal (Exhibit B) stating that the '389 application "is a CONTINUING APPLICATION," and in particular, that the '389 application "is a Continuation of prior U.S. Patent Application Serial No. 09/927,850 filed August 10, 2001" (Declaration, ¶ 3). The Utility Patent Application Transmittal, which was filed on August 8, 2005, is evidence that Applicants did not intend to abandon the '850 application on March 7, 2005. Had the abandonment of the '850 application on March 7, 2005 been Applicants' deliberately chosen course of action, Applicants would have been unable to claim the benefit of the '850 application, since there would have been a lack of copendency between the '850 application and the '389 application.

In addition to the Utility Patent Application Transmittal, Applicants note that the twenty claims that were presented at the time the '389 application was filed (Exhibit C) were identical to the twenty claims presented on June 10, 2004 during prosecution of the '850 application (Exhibit D) (Declaration, ¶ 4). Moreover, at the time the '389 application was filed, Dr. Zuhn filed a copy of the Declaration and Power of Attorney for Patent Application that was originally filed with U.S. Application No. 09/724,860 ("the '860 application") (Exhibit E) (Declaration, ¶ 4). Because the '850 application is a divisional application of the '860 application, the '389 application is entitled to the filing date of the '860 application, but only if the '389 application is a proper continuation of the '850 application. Thus, all evidence in the record indicates that on August 8, 2005, Applicants intended to file the '389 application as a continuation of the '850 application. Applicants, therefore, could not have intended the '850 application to become abandoned on March 7, 2005.

To secure the benefit of '850 application – as the evidence above indicates was Applicants' intent – a five-month extension of time should have been filed in the '850 application on August 8,

2005<sup>1</sup>, the date on which the '389 application was filed. The evidence described above – as well as Dr. Zuhn's Declaration (¶ 5) – indicates that the omission of the request for extension of time in the '850 application was inadvertent and not intentional, since copendency between the '850 application and the '389 application would have been required for the '389 application to properly claim the benefit of the '850 application as a continuation of that application.

In his Declaration, Dr. Zuhn avers that he received and reviewed a Filing Receipt (Exhibit F) for the '389 application in September 2005 (Declaration, ¶ 6). The Filing Receipt, which was mailed September 15, 2005, indicates that the '389 application "is a CON of 09/927,850 8/10/2001" (Exhibit F). Dr. Zuhn also avers that on October 10, 2005, he sent a reporting letter to the Assignee of the '389 application, noting that the Filing Receipt had been reviewed and the information on it (including the priority claim to the '850 application) had been found to be accurate (Declaration, ¶ 6). At the time the Filing Receipt was received, the Office provided no indication that the '850 application had gone abandoned on March 7, 2005 (and therefore, that the '389 application was not properly entitled to the benefit of the '850 application), and neither Applicants nor their representatives had any reason to understand that the '850 application had gone abandoned on March 7, 2005 (Declaration, ¶ 6). As Applicants and their representatives believed, upon receipt of the Filing Receipt, that Applicants were entitled to the benefit of the '850 application, and further, that this benefit claim had been perfected, it is clear from the evidence described above that Applicants did not intend for the '850 application to become abandoned on March 7, 2005.

In his Declaration, Dr. Zuhn avers that he received and reviewed another, Updated Filing Receipt (Exhibit G) for the '389 application in November 2005 (Declaration, ¶ 7). The Updated Filing Receipt, which was mailed October 24, 2005, indicates that the '389 application "is a CON of 09/927,850 8/10/2001" (Exhibit G). Dr. Zuhn also avers that on November 7, 2005, he sent a reporting letter to the Assignee of the '389 application, noting that the Updated Filing Receipt had been reviewed and the information on it (including the priority claim to the '850 application) had been found to be accurate (Declaration, ¶ 7). At the time the Updated Filing Receipt was received, the Office provided no indication that the '850 application had gone abandoned on March 7, 2005

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<sup>1</sup> Applicants note that because August 6, 2005 was a Saturday, the filing of the request for extension of time would have been timely had it been filed on August 8, 2005.

(and therefore, that the '389 application was not properly entitled to the benefit of the '850 application), and neither Applicants nor their representatives had any reason to understand that the '850 application had gone abandoned on March 7, 2005 (Declaration, ¶ 7). Applicants' and their representatives' understanding that Applicants were entitled to the benefit of the '850 application, and further, that this benefit claim had been perfected, was reinforced by receipt of the Updated Filing Receipt. It is clear from the evidence described above that Applicants did not intend for the '850 application to become abandoned on March 7, 2005.

In his Declaration, Dr. Zuhn avers that he received and reviewed a Notice of Abandonment (Exhibit H) for the '850 application in November 2005 (Declaration, ¶ 8). The Notice of Abandonment states that '850 application was "abandoned in view of . . . Applicant's failure to file to timely file a proper reply to the Office letter mailed on 06 January 2005" (Exhibit H). As described above, a Notice of Appeal was filed on January 6, 2005, and the Notice of Appeal was withdrawn by Applicants' filing of a continuation application. However, the Office provided no indication in the Notice of Abandonment that the '850 application had gone abandoned on March 7, 2005, and neither Applicants nor their representatives had any reason to understand that the '850 application had gone abandoned on March 7, 2005 (Declaration, ¶ 8). Thus, it is clear from the evidence described above that at the time the Notice of Abandonment was received, Applicants did not intend for the '850 application to become abandoned on March 7, 2005.

In his Declaration, Dr. Zuhn avers that he received a first Office Action (Exhibit I) for the '389 application in November 2007 (Declaration, ¶ 9). The Action, which was mailed on November 23, 2007, contains a section entitled "Priority," in which the Examiner notes that the '389 application "appears to claim subject matter disclosed in prior Application No. 09/927,850, filed 8/10/2001," but requires that "[a] reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c)" (Exhibit I). The Examiner did not, however, indicate in the Action that the '850 application went abandoned on March 7, 2005, and therefore, that such a priority claim would be improper (Exhibit I).

On December 23, 2008, Dr. Zuhn filed a response (Exhibit J) to the Office Action mailed November 23, 2007 in the '389 application (Declaration, ¶ 10). Pursuant to the Examiner's request in

the Action, Dr. Zuhn also filed a Petition for an Unintentionally Delayed Domestic Priority Claim (Exhibit K)<sup>2</sup>, and amended the specification of the '389 application to insert a reference to the '850 application (as well as to the '860 application and U.S. Provisional Application No. 60/169,720) as the first sentence of the specification (Declaration, ¶ 10). Applicants' attempt to secure the benefit of the '850 application by filing a Petition for an Unintentionally Delayed Domestic Priority Claim and amending the specification to insert a reference to the '850 application is inconsistent with a deliberately chosen course of action to abandon the '850 application on March 7, 2005. Moreover, in the response to the Office Action mailed November 23, 2007, Dr. Zuhn suggested that an interference be declared between the '389 application and U.S. Patent No. 6,433,145, which issued from U.S. Application No. 09/487,792, which was filed on January 20, 2000 (Exhibit J; Declaration, ¶ 12). Therefore, for an interference to be declared, Applicants required the benefit of the '850 application's filing date, which Applicants believed they were entitled to at the time the response was filed.

In his Declaration, Dr. Zuhn avers that only when he received and reviewed the Decision on Petition under 37 CFR 1.78(a)(3) and under 37 CFR 1.78(a)(6) (Exhibit L) in March 2009, did he discover that the '850 application had become abandoned on March 7, 2005 (Declaration, ¶ 13). The Decision (Exhibit L) states at page 2 that:

There does not appear to be copendency between the present application and application no. 09/927,850. A final Office Action was mailed July 6, 2004. In response a Notice of Appeal was filed January 6, 2005 with a three month extension of time, to which an Appeal Brief was due by March 6, 2005 or with a five month extension of time, could have been filed August 6, 2005. A request for an extension of time was not made in the 09/927,850 application. Thus, the '850 application became abandoned as of midnight August 6, 2005 and was not active when the present application was filed August 8, 2005. It is suggested that petitioners file a petition for revival in the '850 application for the purposes establishing copendency with the present application.

Thus, Dr. Zuhn avers that upon receipt of the Decision in March 2009, he first learned that the '850

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<sup>2</sup> Dr. Zuhn discovered the Filing Receipt (Exhibit F) and Updated Filing Receipt (Exhibit G) for the '389 application following a recent investigation of the '389 application file (Declaration, ¶ 11). At the time the Petition for an Unintentionally Delayed Domestic Priority Claim (Exhibit K) was filed, Dr. Zuhn was unaware of these filing receipts, and he could not locate copies of either filing receipt on Private PAIR in the Image File Wrapper for the '389 application (*id.*).

application had become abandoned on March 7, 2005 (Declaration, ¶ 13). Dr. Zuhn subsequently informed Applicants' undersigned representative and Assignee for the '389 application of the Decision (Declaration, ¶ 13). Following an investigation into the circumstances of the abandonment, Dr. Zuhn filed a Petition to Revive an Unintentionally-Abandoned Application, seeking to revive the '850 application for the purpose of establishing copendency with the '389 application (Declaration, ¶ 14). Applicants contend that evidence in the record clearly indicates that the abandonment of the '850 application on March 7, 2005 was unintentional, and that at no time from March 7, 2005 until the submission of this Renewed Petition did Applicants intend for the '850 application to become abandoned on March 7, 2005.

Pursuant to 37 C.F.R. § 1.137(b), Applicants contend that the '389 application (which Applicants filed on August 8, 2005 as a continuation of the '850 application) constitutes the required reply (M.P.E.P. § 711.03(b)(II)(A)(2)(c)). To the extent that a petition fee is required, Applicants authorize the Commissioner to charge \$1,620.00 for the fee under 37 C.F.R. § 1.137(b)(2), pursuant to 37 C.F.R. § 1.17(m), to Deposit Account No. 13-2490. In addition, to the extent that an extension of time fee is required, the Commissioner is authorized to charge the amount of \$2,350.00 for the fee under 37 C.F.R. § 1.136(a), pursuant to 37 C.F.R. § 1.17(a)(3), to Deposit Account No. 13-2490. Applicants state that the entire delay in filing the required reply from the due date for that reply until the filing of this Renewed Petition was unintentional. Finally, Applicants respectfully contend that no terminal disclaimer is required in this case.

Applicants also contend that the additional information discussed above indicates that the entire delay in seeking to revive the '850 application was unintentional. In other words, Applicants contend that evidence in the record clearly indicates that the abandonment of the '850 application on March 7, 2005 was unintentional, and that at no time from March 7, 2005 until the submission of this Renewed Petition did Applicants intend for the '850 application to become abandoned on March 7, 2005<sup>3</sup>. Applicants also contend that because they only recently learned of the abandonment of the '850 application, Applicants failure to seek the revival of the '850 application does not constitute a deliberately chosen course of action (or inaction), but rather indicates that the delay in seeking to

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<sup>3</sup> Applicants note that while the Decision on Petition mailed July 13, 2009 states that the delay in resuming prosecution of the '850 application is "over 4 years," Applicants did not become aware of the abandonment of the '850 application until March 2009 (Declaration, ¶ 13).

revive the '850 application was unintentional. Applicants further contend that the evidence in the record indicates that the '850 application went abandoned on March 7, 2005 despite the exercise of due care and diligence.

Applicants, therefore, respectfully contend that the Renewed Petition satisfies the requirements of 37 C.F.R. § 1.137(b) for a grantable petition, and request that the Office grant their Renewed Petition under 37 CFR 1.137(b). If any Patent Office official believes it to be beneficial, he or she is invited to contact the undersigned representative by telephone at 312-913-0001.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff LLP**

By: \_\_\_\_\_

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Dated: August 17, 2009